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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/811,348      | 03/16/2001  | Steve Tilman         | 40655-201257        | 7734             |

7590 06/17/2005

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| EXAMINER |
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NGUYEN, TAN D

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| ART UNIT | PAPER NUMBER |
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3629

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 09/811,348             | TILMAN, STEVE       |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | Tan Dean D. Nguyen     | 3629                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 17 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 19-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Group I, claims 1-15 (method<sup>1</sup>), 16, 19-25 (method<sup>2</sup>), 26-27 (apparatus<sup>1</sup>), in the reply filed on 3/29/05 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Claims 17-18 are withdrawn.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 1-15 (method<sup>1</sup>), 16, 19-25 (method<sup>2</sup>) are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

In order for the claimed invention to be statutory subject matter, the claimed invention must fall within one of the statutory classes of invention as set forth in § 101 (i.e. a process, machine, manufacture, or composition of matter).

In the present case, method claims 1-15, 16, 19-25 are directed to a "method of selecting one or more colors", which is not within one of the classes of invention set forth in § 101.

The "method of selecting one or more colors" comprising the steps of:

- (a) selecting a location ... ;
- (b) selecting .... ;
- (c ) associating a functionality value ...;

- (d) using ....;
- (e) associating ... ;
- (f) using said AOL value ...;
- (g) associating an exposure ...;
- (h) using said exposure ...;
- (i) selecting ... ;
- (j) using said spatial emphasis ...;
- (k) optionally selecting ... and selected columns”,

are merely an abstract idea and do not produce a useful, tangible, concrete results.

The “method of selecting one or more colors” comprising the steps of (a)-(k) (or (1)-(11) as shown are merely an abstract idea and does not reduce to a practical application in the technological arts (involving computer/computing means or equivalent for determination/calculation) and are therefore are found to be non-statutory. Note that the insertion of the term “in a computer system” in the preamble is insufficient since to receive any patentable weight, this phrase must appear in the body of the claim and a computation step using the computer is necessary to overcome the rejection.

See (1) *In re Schrader*, 22 F.3d 290, 30 USPQ2d 1455 (CCPA 1994), (2) *In re Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557, (3) *In re Waldbaum*, 173 USPQ 430 (CCPA 1972), (4) *In re Musgrave*, 167 USPQ 280 (CCPA 1970), and (5) *In re Johnston*, 183 USPQ 172.

***Claim Objections***

4. Dependent claims 10, 11, 12, 13, 14, 15 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim dependent upon multiple dependent claims (9) and (10). See MPEP § 608.01(n). Accordingly, the claims 10-15 are not been further treated on the merits.

***Claim Rejections - 35 USC § 112***

5. Claims 16, 19-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent method claim 16 is vague and indefinite because it fails to include method steps to carry out the method of claim 16. The phrase “comprising the method of claims 11, 12, 13, 14 and 15” is improper and vague and indefinite. Moreover, claims 11-15 are objected as indicated above for improper multiple dependent claims and are not been further treated on the merits. Therefore, claim 16 is also not been further treated on the merits.

6. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1,

1) it's not clear how steps (3), (5), and (7) are carried out?

2) Step (10) is vague and indefinite because it's not clear how this step is complete with the “said 4<sup>th</sup> set of selected rows and columns” optionally being a subset.

3) It's not clear how the scope of the claimed invention to be carried with the last two steps, (10) and (11), being "optional" or not needed.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 26-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Article 2/1999.

Article 2/99 discloses a system having a plurality of computer executable steps to implement and control a color selection system, the system comprising:

(1) an interface for displaying one or more selection criteria and for inputting user preferences {see pages 1-2). As for the method steps of (1) displaying, (2) storing, (3) using, (4) storing, (5) transmitting and (6) optionally executing, they carry no patentable weight in an apparatus claim. Note that the terms/steps following "optionally" on (6) also receive no patentable weight because this is optional and not required and the examiner takes the "optional" position.

Note, that in an apparatus claim, only structural elements or features of the apparatus receive patentable weight or in terms of structure rather than function.

"Apparatus claims cover what a device is, not what a device does". Hewlett-Packard

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Co. vs. Bausch & Lomb Inc, 909 F. 2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

As for dep. claim 27 (part of 26), this is taught in pages 1-2. See also [www.gecolorexpress.com](http://www.gecolorexpress.com).

No claims are allowed.

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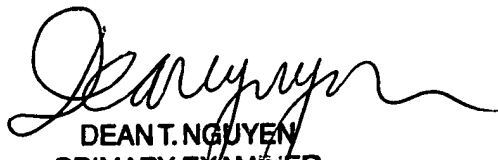
9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail [CustomerService3600@uspto.gov](mailto:CustomerService3600@uspto.gov).

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (571) 272-6812. The FAX phone numbers for formal communications concerning this application are (703) 872-9306. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn  
June 13, 2005

  
DEAN T. NGUYEN  
PRIMARY EXAMINER